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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,479	12/17/2001	Domingo Rohde	81,485/LPK	2759
7590	02/05/2004		EXAMINER	
Lawrence P. Kessler NexPress Solutions LLC Patent Department 1447 St. Paul Street Rochester, NY 14653-7103			DOTE, JANIS L	
			ART UNIT	PAPER NUMBER
			1756	
DATE MAILED: 02/05/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/022,479

Applicant(s)

ROHDE ET AL.

Examiner

Janis L. Dote

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12, 14 and 17-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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1. The examiner acknowledges the cancellation of claims 13, 15, 16, 21, and 22, and the amendments to claims 12, 14, and 17-20, filed on Nov. 24, 2003. Claims 1-12, 14, and 17-20 are pending.

The amendment to the claims filed on Oct. 6, 2003 (Amdt100603), was not in compliance with 37 CFR 1.121 for the reasons set forth in the Notice of Non-compliant Amendment mailed on Nov. 12, 2003. The amendment to the claims has not been entered.

2. Applicants' election of the invention of Group II, which now consists of instant claims 12, 14, and 17-20, in Amdt100503 is acknowledged. Because applicants did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 1-11 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election in Amdt100603 been treated as an election made **without** traverse.

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3. The objections to the specification set forth in the office action mailed on Apr. 28, 2003 (CTNF042803), paragraph 6, items (2) through (5), have been withdrawn in response to the amendments to claims 17 to 20, respectively.

The rejections of claims 19, 21, and 22 under 35 U.S.C. 112, second paragraph, set forth in CTNF042803, paragraph 8, have been withdrawn in response to the amendment to claim 19, and the cancellation of claims 21 and 22.

The rejection of claims 12-14 and 16-19 under 35 U.S.C. 102(b) over US 5,149,610 (Kobayashi), set forth in CTNF042803, paragraph 11, has been withdrawn in response to the amendment to claim 12, adding the limitation that the toner layer, which comprises a toner that comprises different color pigmented particles, which is suitable to produce the color black, and other toners that produce colors other than black, absorbs less than 10% of the energy as the other toners when irradiated with electromagnetic radiation with a wavelength in the IR range below approximately 5  $\mu\text{m}$ . Kobayashi does not teach a toner that is "suitable to produce the color black" comprising different color pigmented particles, characterized in that when that toner is present in a toner layer comprising other toners that produce colors other than black, the toner layer has the absorption property as recited in instant claim 12. Rather, as discussed

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in CTNF042803, paragraph 11, Kobayashi discloses a black toner that comprises a mixture of a cyan pigment, a magenta pigment, and a yellow pigment, where the black toner absorbs about 20% of the energy when irradiated with light having a wavelength in the wavelength region of 800 to 1000 nm. Kobayashi teaches a black toner layer only comprising said black toner. Kobayashi does not teach a toner layer comprising its black toner and other toners that do not produce the color black, where the toner layer has the absorption property recited in instant claim 12.

4. The drawing is objected to because Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).

An amended drawing as set forth in 37 CFR 1.121 is required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

5. The amendment filed on Oct. 6, 2003 (Amdt106003), is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention.

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The added material which is not supported by the original disclosure is as follows:

The replacement paragraph beginning at page 5, line 12, of the specification, stating that the carbon black amount of "less than 2%" is by weight.

The originally filed specification does not provide antecedent basis for the amount of less than 2% by weight. The originally filed specification at page 5, lines 14-15, discloses that "the color black is formed or formed together with at least one toner layer that has a carbon black portion of less than 2%, preferably noticeably less than 2%." The specification did not identify the basis of the 2%. There is no evidence in the originally filed specification that would have led a person having ordinary skill in the art to recognize readily that the amount of less than 2% is based on weight.

Applicants are required to cancel the new matter in the reply to this Office Action.

6. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

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In claim 12, the recitation "the toner having different color pigmented particles . . . is suitable to produce the color black" lacks antecedent basis in the specification. See page 5, lines 1-3, of the specification, which discloses that "the color black is formed or formed together with at least one toner layer that contains a combination of different colored color pigment particles" (emphasis added). The specification does not disclose a toner having different color pigmented particles as recited in instant claim 12.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 17 is indefinite in the phrase "the toner layer contains a combination of different colored particles that are provided to produce the colors cyan, magenta, and yellow" (emphasis added) for lack of unambiguous antecedent basis. It

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is not clear whether the different colored particles recited in claim 17 refer to the "other toners that are provided to produce colors other than black" or to the different color pigmented particles that are comprised in the toner that is suitable to produce the color black.

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 12, 14, and 17-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

(1) Instant claim 12 and claims 14 and 17-20, which depend from claim 12, recite a toner layer, which comprises a "toner having different color pigmented particles . . . [that] is suitable to produce the color black" and other toners that



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produce other colors than black. The toner layer absorbs "less than 10% of the energy as [the] other toners in the toner layer." In other words, the toner layer has the same absorption of less than 10% of the energy as the other toners.

The originally filed specification does not provide an adequate written description of said toner layer. The specification at page 3, line 30, to page 4, line 2, discloses that "in order to produce the color black at least one toner layer is used that has similar absorption properties, at least for one wavelength within a predetermined wavelength range for the electromagnetic radiation, as the other toner layers that are used" (emphasis added). The specification does not compare to other toners in the same toner layer. The originally filed specification at page 6, lines 14-19, discloses that the toner suitable to produce the color black is "characterized in that it has similar absorption properties, during irradiation by electromagnetic radiation with at least one wavelength out of a predetermined wavelength range, as other customary toners that are provided to produce colors other than black" (emphasis added). The specification at page 7, lines 5-8, discloses that the toner that is suitable to produce the color black "absorbs less than 10% of the energy when it is irradiated with electromagnetic radiation with a wavelength in the IR range

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below approximately 5  $\mu\text{m}$ ." In other words, the specification discloses that a toner that is suitable to produce the color black has an absorption that is similar to the absorption of other toners that produce colors other than black, and the absorption is preferably less than 10% of the energy when the toner is irradiated with electromagnetic radiation with a wavelength in the IR range of below approximately 5  $\mu\text{m}$ . There is no disclosure of a toner layer that absorbs less than 10% of the energy as recited in the instant claims.

(2) When the claim language in claim 17 is interpreted to mean that the different colored particles recited in claim 17 refer to the different color pigmented particles of the toner suitable to produce the color black, the originally filed specification does not provide an adequate written description of the toner layer recited in instant claim 17. The specification does not disclose a toner layer that comprises a toner suitable for forming the color black, which comprises different color pigmented particles that produce the colors cyan, magenta, and yellow, in combination with other toners that produce colors other than black, as recited in instant claim 17. Rather, the originally filed specification discloses that the color black in a color image that is obtained by at least two out of four differently colored toner layers is "formed or

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formed together with at least one toner layer that contains different colored color pigment particles . . . [which] can, for example be formed by color pigment particles that are usually used for the colors cyan, magenta, and yellow." See the specification, page 5, lines 2-5.

(3) Instant claim 18, which depends from claim 12, further recites that the toner layer recited in claim 12 is "not pigmented with carbon black."

The originally filed specification does not provide an adequate written description of said toner layer. The specification does not disclose a toner layer that comprises a toner suitable for forming the color black, which comprises different color pigmented particles, in combination with other toners that produce colors other than black, comprising no carbon black, as recited in instant claim 18. Rather, the originally filed specification at page 5, lines 6-8, discloses that the color black in a color image that is obtained by at least two out of four differently colored toner layers, is "formed or formed together with at least one toner layer that is not pigmented with carbon black."

(4) Instant claim 19, which depends from claim 12, further recites that the toner layer recited in claim 12 contains a portion of carbon black of less than 2% (by weight)."

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The originally filed specification does not provide an adequate written description of said toner layer. Nor does specification identity the amount of less than 2% as a weight percentage. The originally filed specification at page 5, lines 13-15, discloses that the color black in a color image that is obtained by at least two out of four differently colored toner layers, is "formed or formed together with at least one toner layer that has a carbon black portion of less than 2%, preferably noticeably less than 2%." The specification does not disclose that the amount "less than 2%" is a weight percentage as recited in the instant claim. Nor is there any evidence in the originally filed specification that would have led a person having ordinary skill in the art to recognize readily that the amount of "less than 2%" is based on weight. Moreover, the specification does not disclose a toner layer that comprises a toner suitable for forming the color black, which comprises different color pigmented particles, in combination with other toners that produce colors other than black, further comprising carbon black, as recited in instant claim 19.

(5) Instant claim 20, which depends from claim 12, recites that the toner layer recited in claim 12 contains neutral gray pigments.

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The originally filed specification does not provide an adequate written description of said toner layer. The specification does not disclose a toner layer that comprises a toner suitable for producing the color black, which comprises different color pigmented particles, in combination with other toners that produce colors other than black, further comprising neutral gray pigments, as recited in instant claim 20. Rather, the originally filed specification at page 5, lines 25-26, discloses that the color black in a color image that is obtained by at least two out of four differently colored toner layers is "formed or formed together with at least one toner layer that contains neutral gray pigments free from carbon black particles."

11. Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janis L. Dote whose telephone number is (571) 272-1382. The examiner can normally be reached Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Mark Huff, can be reached on (571) 272-1385. The central fax phone number is (703) 872-9306.

Any inquiry of papers not received regarding this communication or earlier communications should be directed to Supervisory Application Examiner Ms. Claudia Sullivan, whose telephone number is (571) 272-1052.

JLD  
1/29/04

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